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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
08/903,743	07/31/1997	TIMOTHY MERRICK LONG	169.0568	2593

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FITZPATRICK CELLA HARPER & SCINTO
30 ROCKEFELLER PLAZA
NEW YORK, NY 10112

EXAMINER

PAULA, CESAR B

ART UNIT PAPER NUMBER

2178

DATE MAILED: 04/22/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application N .

08/903,743

Applicant(s)

LONG ET AL.

Examin r

CESAR B PAULA

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 January 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3,4,7,9-12,27-29,31-33,38 and 42-53 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-53 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ 6) ☐ Other:

DETAILED ACTION

1. This action is responsive to the amendment filed on 1/27/2003.

This action is made Final.

2. In the amendment, claims 16-18, 26, 34-35, 37, and 39-41 have been canceled. Claims 42-53 have been added. Claims 1, 3-4, 7, 9-12, 27-29, 31-33, 38, and 42-53 are pending in the case. Claims 1, 27-29, 31 and 38 are independent claims.

Drawings

3. This application has been filed with informal drawings which are acceptable for examination purposes only. Formal drawings will be required when the application is allowed.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 3-4, 7, 9-12, 22, 27-29, 31, 38 remain, and 42-53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab et al, hereinafter Nehab (Pat. # 6,029,182, 2/22/00, filed on 10/4/96), in view of Davis et al, hereinafter Davis (Pat. # 5,796,952, 8/18/98, filed on 3/21/97).

Regarding independent claim 1, Nehab teaches the creation, by a stand alone *first application*, of a personalized document by collating and arranging various web pages of

Art Unit: 2178

different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 9A). Nehab fails to explicitly disclose: *(a) monitoring a second application operating independently of said first application on said local machine, to identify access patterns of the second application and accessing the hyper-text documents including structure information.* However, Davis discloses the creation of a customized web page based upon the monitoring, and tracking of user(s) interest as selected on a web browser or second application (c.14,L.1-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Nehab and Davis, because Davis teaches providing customized web pages, such as news, sports, entertainment pages, etc, without the necessity of active user's involvement, so as to provide customized web pages without the user's involvement.

Moreover, Nehab teaches the compilation, and fetching of a list of hypertext newspaper pages (c.3, L.15-c.4,L.67).

Furthermore, Nehab teaches the formatting of the various web pages of different newspapers into a single printable document, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67).

Regarding claim 3, which depends on claim 1, Nehab teaches the creation, by a stand alone *first application*, of a personalized document by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 9A). Nehab fails to explicitly disclose:*the printable document is updated upon new hyper-text pages being accessed by the second application.* However, Davis discloses the creation of a customized web page based upon the monitoring, and tracking of

Art Unit: 2178

user(s) interest as selected on a web browser or second application, and assembling a profile of resources geared towards changing user's interest (c.14,L.1-c.15,L.67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Nehab and Davis, because Davis teaches providing customized web pages, such as news, sports, entertainment pages, etc, without the necessity of active user's involvement, so as to provide customized web pages without the user's involvement.

Regarding claim 4, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document of multiple columns (c.14, L.47, and c.16,L.1-67). Nehab fails to explicitly disclose: *.....said steps are performed in a background mode relative to the user's access to the hyper-text documents*. However, Davis discloses the embedding the monitoring application in a web page and monitoring user's selection of web pages in a background process as the user navigates those web pages (c.8,L.1-67, c.14,L.1-c.15,L.67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Nehab and Davis, because Davis teaches providing customized web pages, such as news, sports, entertainment pages, etc, in a transparent fashion, without the necessity of active user's involvement, so as to provide customized web pages without the user's involvement.

Regarding claim 7, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers into a single printable document of multiple columns (c.14, L.47, and c.16,L.1-67).

Regarding claim 9, which depends on claim 1, Nehab teaches the creation of a personalized document by arranging, and printing various web pages of different newspapers

Art Unit: 2178

into a single printable document with an index, and table of contents of the links to articles source links in the web pages (c.14, L.47-67, and c.15,L.20-c.16,L.67). Nehab fails to explicitly disclose:*the printable document comprises a table of contents listing each hyper-text document*

Regarding claim 10, which depends on claim 1, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink references to the articles' sources --....*hyper-link index of at least one hyper link reference* ... (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 11, which depends on claim 10, Nehab discloses formatting different newspaper articles into a single printable document with hyperlink cross-references to an index -*each hyper-link reference in the printable document is tagged with a cross reference to a corresponding entry* ... (c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Regarding claim 12, which depends on claim 10, Nehab discloses including all hyperlink references of each article represented in the formatted document*said hyper-link index comprises all hyper-link references of each hyper-text*--(c.6, L.58-c.7,L.67, and c.15,L.20-c.16,L.67).

Claim 22 is directed towards a method for carrying out the steps found in claim 12, and therefore are similarly rejected.

Regarding independent claim 27, Nehab teaches the creation, by a stand alone *first application*, of a personalized document by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document according to the size of the respective articles (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 9A). Nehab fails to

Art Unit: 2178

explicitly disclose: *monitoring accesses by the second application to the plurality of documents in sequence*. However, Davis discloses the creation of a customized web page based upon the monitoring, and tracking of user(s) interest as selected on a web browser or second application (c.14,L.1-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Nehab and Davis, because Davis teaches providing customized web pages, such as news, sports, entertainment pages, etc, without the necessity of active user's involvement, so as to provide customized web pages without the user's involvement.

Moreover, Nehab teaches the recording, and fetching of a list of hypertext newspaper pages into a single document (c.3, L.15-c.4,L.67).

Furthermore, Nehab teaches the formatting of the various web pages of different newspapers into a single printable document, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67).

Claim 28 is directed towards a computer system for carrying out the steps found in claim 27, and is similarly rejected.

Claim 29 is directed towards a computer readable medium for storing the steps found in claim 1, and is similarly rejected.

Claim 31 is directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and is similarly rejected.

Claim 38 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 27, and is similarly rejected.

Claims 42-45 are directed towards a method for forming a single printable documents for carrying out the steps found in claim 1, and therefore are similarly rejected

Claims 46-47 are directed towards a computer program product having a computer readable medium for storing the steps found in claim 1, and therefore are similarly rejected.

Regarding independent claim 48, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 9A). Nehab fails to explicitly disclose: *monitoring a user's access patterns to the plurality of documents*. However, Davis discloses the creation of a customized web page based upon the monitoring, and tracking over the Internet of user(s) interest as selected on a web browser or second application (c.14,L.1-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Nehab and Davis, because Davis teaches providing customized web pages, such as news, sports, entertainment pages, etc, without the necessity of active user's involvement, so as to provide customized web pages without the user's involvement.

Moreover, Nehab teaches the compilation, and display of a list of links found in the personalized newspaper (c.3, L.15-c.4,L.67, and c.15,L.20-c.16,L.67).

Furthermore, Nehab teaches the formatting of the various web pages of different newspapers into a single printable document by allowing a user to select the portion of the newspaper to be printed, where the various newspapers are contiguously laid out (c.3, L.15-c.4,L.67, and c.15,L.20-c.16,L.67).

Art Unit: 2178

Claim 49 is directed towards a method for forming a single printable documents for carrying out the steps found in claim 48, and is similarly rejected.

Regarding independent claim 50, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers articles into a single linear or continuous printable document (c.3, L.15-c.4,L.67, c.13,L.12-67, fig. 9A). Nehab fails to explicitly disclose: *fetching the document in the compiling step via a network and storing the fetched document in a memory*. However, Davis discloses the creation, and storage of a customized web page based upon the monitoring, and tracking over the Internet of user(s) interest as selected on a web browser or second application (c.14, L.1-67). It would have been obvious to a person of ordinary skill in the art at the time of the invention to have combined the teachings of Nehab and Davis, because Davis teaches providing customized web pages, such as news, sports, entertainment pages, etc, without the necessity of active user's involvement, so as to provide customized web pages without the user's involvement.

Claims 51-53 are directed towards a computer program product having a computer readable medium for storing the steps found in claims 48-50, and therefore are similarly rejected.

6. Claims 32-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nehab, in view of Davis, and further in view of Hayashi et al (Pat. # 5,633,996, 5/27/97, filed on 11/8/94).

Regarding claim 32, which depends on claim 7, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab, and Davis fail to explicitly disclose:*maximizing the number of hyper-text documents on each page*..... However,

Art Unit: 2178

Hayashi et al disclose: “....searching an area for display or printing to which the contents of the document can be laid out.....” (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, Davis, and Hayashi et al, because Hayashi et al teach above search of printable or displayable space the automatic layout of a structured document into a multicolumn document.

Regarding claim 33, which depends on claim 32, Nehab teaches the creation of a personalized document by collating and arranging various web pages of different newspapers into a single printable document (c.3, L.15-c.4,L.67). Nehab, and Davis fail to explicitly disclose:*determining if space exists on a page of the printable document.....if so, inserting the formatted hyper-text document.....* However, Hayashi et al disclose: “....searching an area for display or printing to which the contents of the document can be laid out.....” (Col. 3, lines 7-24). It would have been obvious to a person of ordinary skill in the art at the time of the invention to had combined the teachings of Nehab, Davis, and Hayashi et al, because Hayashi et al teach above search of printable or displayable space the automatic layout of a structured document into a multicolumn document.

Response to Arguments

7. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection. The Applicant state that neither Nehab, nor Davis teach or suggest the newly introduced limitation of monitoring a second application operating independently of the first application on the local machine (p.16,L.5-21). The Applicants are referred to the rejection of the newly added features as noted above.

Regarding the remark that prior art does not teach the limitations of claims 48, and 51 (p.18,L.18-16, p.19,L.4-5), the Applicant is directed towards the rejections of these claims above as necessitated by the current amendment.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

I. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Cesar B. Paula whose telephone number is (703) 306-5543. The examiner can normally be reached on Monday through Friday from 8:00 a.m. to 4:00 p.m. (EST).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon, can be reached on (703) 308-5186. However, in such a case, please allow at least one business day.

Art Unit: 2178

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Any response to this Action should be mailed to:

Director United States Patent and Trademark Office

Washington, D.C. 20231

Or faxed to:

- (703) 746-7238, (for **After Final** communications intended for entry)
- (703) 746-7239, (for **Formal** communications intended for entry, **except formal After Final communications**)

Or:

- (703) 746-7240, (for **Informal or Draft** communications for discussion only, please label **"PROPOSED"** or **"DRAFT"**).

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

CBP

4/21/03



STEPHEN S. HONG
PRIMARY EXAMINER